



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,027	10/17/2001	Guenaelle Martin	214862US0	3816

22850 7590 11/21/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 11/21/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,027

Applicant(s)

MARTIN ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 6, 2003 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Boussouira (EP 2779060).

Boussouira teaches a cosmetic composition comprising retinol and histidine. See abstract; English equivalent (US 6358514 B1). The reference teaches that it is well known in the art to add sunscreen agent "to reinforce the stability" of the retinoid-polyamino polymer combination by "limiting the harmful action of UV on the retinoid". The reference teaches using camphor derivatives among other sunscreens, and particularly mentions benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid). See Boussouira, p. 8, line 35 – p. 9, line 19; '514 patent, p. 7, line 52 – col. 8, line 13. The reference teaches using 0.0001 – 10 % by weight of retinoid. See Boussouira, p. 9,

Art Unit: 1617

line 38 – p. 10, line 3; '514 patent, col. 8, lines 36 – 43. The reference also teaches o/w emulsion form of the invention. See Boussouira, Example 2. The reference teaches the claimed method of treating and preventing photoinduced aging skin by applying a composition comprising retinoid. See Boussouira, p. 1, lines 2 – 35; '514 patent, col. 1, lines 17 – 44.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding (US 5705144) in view of Forestier et al. (US 5302376) ("Forestier").

Harding teaches a cosmetic composition comprising retinoid and a dioc acid. See abstract. The reference teaches "co-formulation with a sunscreen enhances the photo-stability and activity of retinal or its derivative within the formulation and also prevent further actinic damage to all epidermal cells". See col. 2, lines 51 – 62. The reference teaches using 0.5 – 5 % by weight of the retinoid. See col. 3, lines 10 – 14; instant claim 3. See col. 6, line 45 – col. 8, line 11 for useful sunscreens including Benzophenone –3, octyl salicylate, octyl methoxy-cinnamate. See instant claims 6-10.

Harding fails to teach benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid).

Forestier teaches a cosmetic emulsion comprising benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid) as the active UV screening agent. See abstract. The reference teaches using 0.1-10 % of the UV screening agent by weight of the emulsion. See col. 3, line 61 – col. 4, line 5; instant claim 4. The reference teaches

Art Unit: 1617

o/w emulsion. See col. 4, lines 6 – 10; instant claim 5. The reference teaches that the screening agent provides sufficient screening for sensitive skin, and produces high sun-protection at low concentration. See col. 2, lines 2, and lines 1 – 24. The reference also teaches that the composition is advantageous in that it is thermally and photochemically stable, not toxic and harmless to the skin. See col. 2, lines 64 – 68. Examiner views that the recited stability of retinoid is a resulting physical property of the obvious variation of the prior arts.

Given the general teaching of stabilizing retinoid by adding sunscreen agent in Harding, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have looked to the prior art such as Forestier for specific sun screening agent. The skilled artisan would have been modified the composition of Harding by adding benzene-1, 4-bis (3-methyldidene-10-camphorsulphonic acid) as motivated by Forestier because of an expectation of successfully producing a stable retinoid composition. The motivation to add the specific sun screening agent is found in the teachings of the Boussouira reference and particularly in Forestier reference which teaches that the camphor derivatives exhibits high sun-protection at low concentration, and produces both thermally and photochemically stable composition without toxicity.

Response to Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

11/3/03